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#### **REMARKS**

This Amendment is submitted in response to the Office Action mailed on March 14, 2006. Claims 1 - 29 are pending, and all stand rejected at present.

It is believed that amendments to the claims have removed all bases for 112 - objections.

#### **RESPONSE TO ANTICIPATION REJECTIONS**

Claims 1, 2, 4, 7 - 9, 11, 14 - 17, 19 - 22, and 24 - 29 were rejected on grounds of anticipation, based on De Leo.

#### **Claim 1**

Original claim 1 recited

(a) collecting environment data related to the environment of each terminal such as its location and/or the nature of businesses nearby the terminal.

Three passages of De Leo are cited to show this:

Passage 1: column 6, lines 42 - 65;

Passage 2: column 7, line 23 - column 8, line 4; and

Passage 3: column 8, lines 24 - 43.

However, none of these Passages shows "collecting environment data."

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Passage 1 merely discusses displaying advertising on an ATM screen.

Passage 2 merely discusses steps undertaken by an ATM, and states that advertising is displayed between those steps.

Passage 3 merely states that advertising can be displayed prior to an ATM transaction. Also, Passage 3 states one way of selecting the type of advertising to be displayed.

None of the three passages discusses "collecting environment data."

Amended claim 1 recites

(a) collecting environment data related to the environment of each terminal ~~such as its location and/or~~ including the nature of businesses nearby the terminal.

The undersigned attorney cannot locate any collection of data in De Leo which indicates "the nature of businesses nearby the terminal" as claimed.

MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicant therefore submits that, since claim 1(a) is not found in De Leo, the anticipation rejection cannot stand.

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C.

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§ 132, that the PTO specifically identify the claimed "environment data" in De Leo.

Applicant points out that the PTO cites about 100 lines of De Leo, in order to show a claim recitation which is four lines in length. Under these circumstances, MPEP § 707(2) seems applicable, which states:

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

Applicant requests that the "particular part relied on" be identified.

#### Claim 2

Claim 2 recites:

2. A method according to claim 1, further comprising the step of:

(d) collecting advertising data ~~related to~~ which describes the type and content of one or more advertisement displayed on ~~and/or~~ adjacent to the terminal at particular times.

The Office Action relies on Passages 2 and 3, above, to show this.

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Applicant points out that claim 2, in effect, states that a **history** of the type of advertising displayed is created. Passages 2 and 3 do not show that.

#### **Claim 4**

Claim 4 recites "real time." That term is defined in the Specification, page 5, line 8 et seq.

Thus, in effect, claim 4 states that the "collecting" of "environment data" of claim 1 occurs when the transactions occur. This can be useful in the following example.

Suppose that a specific event is occurring near the terminal. The terminal may display advertising about the event. Collection of the data, in "real time" as claimed, can assist in evaluating the effectiveness of the advertising. If an attempt to collect the data were postponed, say, for a week, then events which occurred may not be detectable at that time. Perhaps no one kept records of such events.

The Office Action relies on Passages 2 and 3, above, to show the claim. However, an examination of those Passages fails to show collection of "environment data," let alone collection in the claimed "real time."

The Office Action also relies on column 5, line 43 - column 6, line 7 of De Leo. This will be called Passage 4. However, Passage 4 merely states that

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- 1) information about a customer is kept in a "configuration file," and
- 2) relevant advertising is selected for the customer based on the "configuration file."

That does not show collecting "environment data" in "real time."

Further, De Leo does not show the basic idea behind claim 4, as illustrated by the example given above.

Applicant specifically requests that "collecting" "environment data" "in real time" be identified in De Leo.

#### **Claim 7**

##### Point 1

The Office Action relies on three passages in De Leo to show claim 7(e):

Passage 1 (as above): column 6, lines 42 - 65;

Passage 3 (as above): column 8, lines 24 - 43; and

Passage 5 (new): column 6, lines 7 - 22.

Claim 7(e) recites determining "which terminals are located on sites at which a selected business activity is carried out."

Passage 1 merely discusses displaying advertising on an ATM screen.

Passage 3 merely states that advertising can be displayed

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prior to an ATM transaction. Also, Passage 3 states one way of selecting the type of advertising to be displayed.

Passage 5 merely states how the "configuration file," discussed above, is updated at the ATM.

None of the Passages shows claim 7(e).

Applicant specifically requests that the following be identified in De Leo:

- The claimed "business activity."
- The "terminals" "located" on the "sites" of that "business activity."
- The process of "identifying" those "terminals."

#### Point 2

Claim 7(e) states that the "identifying" just discussed is done through a "query" on "**THE** data warehouse." "**The** data warehouse" is that recited in parent claim 1.

Thus, "data" which was collected in claim 1 is "queried" in order to "identify" "terminals" "located" on the "sites" of the selected "business activity."

Applicant cannot locate this operation in De Leo, and requests that it be precisely identified.

Applicant specifically requests that the "data warehouse" be identified.

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**Claim 8**

Point 1

Claim 8 recites

querying the data warehouse to calculate a statistical distribution of the frequency of different transactions occurring at a terminal.

The Office Action relies on two passages in De Leo to show this recitation, namely,

Passage 5 (as above): column 6, lines 7 - 22;

and

Passage 6 (new): column 5, lines 19 - 60.

Passage 5 merely states how the "configuration file," discussed above, is updated at the ATM.

Passage 6 discusses the "configuration files" discussed above, which contain information about customers. Such files are used to select appropriate advertising for the customer.

The undersigned attorney can locate no "statistical distribution" as claimed in these Passages, and requests that it be identified.

Point 2

Claim 8(f) states that an advertisement is selected, based on

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the "statistical distribution." The Specification, page 3, line 15 et seq., provides an example:

For example, a terminal may be operable to print a map showing the location of an entertainment event occurring near the terminal.

Having calculated the statistical distribution of the transactions at that terminal, it is possible to see if a statistically significant number of users are requesting the map.

It may then be appropriate to present advertising material related to the event shown on the map (to generate more requests for the map and therefore more interest in the event) or even to advertise an event of a related type (for example to sporting or tourist activities).

The related event may be operated by the same company as that for which the map is printed.

The Office Action cites part of Passage 6 to show this. However, as explained above, Passage 6 discusses a "configuration file." No "statistical distribution" as claimed is found in that file.

Therefore, Applicant requests that the claimed "selecting an advertisement" based on the "statistical distribution" be identified in De Leo. Applicant also requests that the "statistical distribution" be precisely identified.



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**Claim 9**

The discussion of claim 1 applies to claim 9.

Claim 9 recites collecting data about the environment of the terminal. That has not been shown in De Leo.

Claim 9 recites, in effect, creating a history of the advertising displayed at the terminal. That has not been shown in De Leo.

**Claim 11**

The discussion of claim 2 applies to claim 11.

Collecting data about the environment of the terminal in real time with transactions at the terminal has not been shown in De Leo.

**Claim 14**

The discussion of claim 7 applies to claim 14.

**Claim 15**

The discussion of claim 8 applies to claim 15.

**Claim 16**

Point 1

The discussion of claim 1 applies to claim 16. The claimed "environment data" is not found in De Leo.

Point 2

The last phrase of claim 16 states that the data is derived in "real time." Thus, a user can select advertising based on **new, current** information which was not previously contained in the data warehouse.

De Leo is directly contrary to this. De Leo states that advertising is selected based on the "configuration file." (Column 5, line 44 et seq.) But De Leo states that the "configuration file" is updated, and a **time delay** occurs before a new "configuration file" becomes active. (Column 6, line 7 et seq.) Specifically, De Leo states that new "configuration files" are sent out on a "periodic basis." (Column 6, line 8.)

That is directly contrary to the "real time" recitation of the claim. For example, just prior to the replacement of a "configuration file" in De Leo, the information contained in it is stale, and is not "real time" information.

**Claim 17**

Claim 17, in effect, recites creating a **history** of advertising displayed at the terminal. That is not found in De Leo.

The Office Action cites over 150 lines of De Leo to show claim 17. Applicant points to MPEP § 707(2), which states:

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- (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

Applicant requests that the "particular part relied on" be identified.

#### **Claim 19**

The discussion of claim 7 applies to claim 19.

#### **Claim 20**

The discussion of claim 8 applies to claim 20.

#### **Claim 21**

Claim 21 recites:

determining which transactions occur at one or more terminal within a predetermined time period of [a public event].

The Office Action relies on part of Passage 6 to show this.

The undersigned attorney has re-read the part of Passage 6 relied on, and can see no relevance to claim 21. Therefore, it is requested that the following be specifically identified in De Leo:

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- the claimed "transactions" which are determined (ie, identified);
- the claimed "predetermined time;" and
- the "event."

#### **Claim 22**

The discussion of claim 1 applies to claim 22. Specifically, no "enviroment data" as claimed is seen in De Leo.

#### **Claim 24**

The discussion of claim 7 applies to claim 24.

#### **Claim 25**

The discussion of claim 8 applies to claim 25.

#### **Claim 26**

The discussion of claim 21 applies to claim 26.

#### **Claim 27**

Claim 27 recites:

means for sending information to the network which identifies which transactions are occurring at the terminal and at what time they occur.

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Point 1

The Office Action cites over 125 lines of De Leo, in order to show this simple recitation. Applicant cannot locate this recitation, or anything suggesting it, in those cited lines.

Applicant points to MPEP § 707(2), which is repeated here:

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

Applicant requests that the "particular part relied on" be identified.

Point 2

De Leo states that a "host computer" controls the ATM. (Column 3, line 31 et seq.) Therefore, the "host" already knows what transactions are occurring at the ATM. Consequently, there is no reason for the ATM to transmit the claimed "information" to the host.

This leads to the inference that De Leo does not show the claim recitation.

**Claim 28**

Point 1

The discussion of claim 27 applies to claim 28. De Leo states that "message processor 28" (at the "host" - see De Leo's Figure 1) sends "non-transaction messages" (eg, advertising) to the ATM. (Column 3, line 39 et seq.)

Thus, the "host" knows what advertising is displayed at the ATM. Consequently, there is no reason for the ATM to transmit the claimed "information" to the host.

This leads to the inference that De Leo does not show the claim recitation.

Point 2

Parent claim 27 states that the terminal sends information about "transactions" which occur. Thus, claims 27 and 28 together state that the terminal sends information about the "transactions" and also about the "advertising" displayed during the transactions.

That is not seen in De Leo.

**Claim 29**

The discussion of claims 27 and 28 apply to claim 29.

In addition, claim 29 recites:

(d) analyzing the terminal network by  
querying the data in the database.

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The Office Action cites numerous passages in De Leo as showing this recitation. However, the undersigned attorney cannot find querying a database which contains information about transactions at terminals, together with advertising displayed in connection with those transactions.

Therefore, it is specifically requested that the following be identified in De Leo:

- the claimed "database;"
- the claimed data, stored in the database, about "transactions" and the "advertising" displayed with those "transactions;" and
- the claimed "querying."

#### **RESPONSE TO OBVIOUSNESS REJECTIONS**

Claims 3, 5, 6, 10, 12, 13, 18, and 23 were rejected as obvious, based on De Leo and Calvey.

#### **Claim 3**

Claim 3 recites:

3. A method according to claim 1, wherein the plurality of terminals are distributed across more than one deployer network.

De Leo is cited to show parent claim 1, and Calvey is cited to show claim 3.

Even if References are Combined, Claim 3 is not Attained - Part 1

The cited passages of Calvey (page 1, paragraphs 3 and 4) merely show two "deployer networks" (one owned by Visa International, and one owned by BankAmerica.)

But claim 3 states that the terminals in **both "deployer networks"** perform the actions of claim 1. Calvey does not state that the terminals in both networks perform those actions.

Nor does Calvey state that those terminals in both networks perform similar actions. And it would be reasonable to assume that those terminals perform **different** actions, since they would be programmed by different entities.

Again, Calvey merely points to two different networks. The existence of two different networks does not show claim 3.

Therefore, even if the references are combined, this aspect of the claim is missing.

Even if References are Combined, Claim 3 is not Attained - Part 2

Parent claim 1 recites a **single** "data warehouse." Dependent claim 3 states that data from terminals in "more than one deployer network" is collected. Under the language of the claims, that data is placed into the (single) "data warehouse."

That has not been shown in the references, even if combined.



No Teaching Given

No valid teaching has been given in favor of combining the references.

The rationale given is that the combination "[reaches] a greater audience of users that frequent different deployer networks." However, several problems exist in this rationale.

PROBLEM 1

No evidence has been given in support of the rationale. That is, prior to the combination of references, a certain number of ATMs are present, and a certain number of customers are present.

After the combination, the same number of ATMs are present, and the same number of customers are present.

No evidence has been given showing that a "greater audience of users" has been reached.

Without evidence, the rationale is a naked conclusion, which is not allowed.

PROBLEM 2

No basis of comparison has been given. Thus, it cannot be determined whether the rationale is correct.

That is, the rationale asserts that a "greater audience" is reached. Applicant asks: "Greater than what ?"

A basis of comparison is required, in order to determine

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whether the rationale is correct.

#### PROBLEM 3

The rationale does not, as a matter of logic, lead to a combination of the references.

Calvey discusses two ATM networks. It seems plain that those two networks, together, "reach" a larger "audience" than either network by itself. Thus, if the goal is to reach a larger audience with ATMs, then all you need do is add more ATM networks.

De Leo's system is not needed to add more ATM networks.

The rationale does not, as a matter of logic, lead to a combination of the references. De Leo is not needed to reach a greater audience.

#### PROBLEM 4

The rationale merely describes a supposed characteristic of the references, but **after being combined**. That is not a teaching for combining the references in the first place.

MPEP § 706.02(j) requires a teaching:

#### Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

. . .

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(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . .

**The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.**

The rationale used to combine the references has not been shown in the prior art, as required by this MPEP section.

#### PROBLEM 5

Even if the PTO's rationale be accepted (ie, the goal is to reach a "greater audience"), no logical connection leading to the combination of references has been given.

That is, you can reach a "greater audience" by simply adding more ATMs to De Leo's system. You need not use "more than one deployer network" as claimed.

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PROBLEM 6

No expectation of success has been shown, indicating that the combination of references actually works as claimed.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

That is, claim 1 states that the data collected is stored in "a data warehouse," which is **singular** in number. Claim 3 states that data is collected from terminals in "more than one deployer network." Under the claim language, that "data" is stored in the (single) "data warehouse."

The Office Action has not shown how this is done in the combination of references. No expectation of success has been shown.

From another perspective, an element is missing. The PTO has not shown in the prior art any device which can extract data from

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ATMS in two different networks, and place the data into a **single** "data warehouse."

#### **Claim 5**

##### Even if References are Combined, Claim 5 is not Attained

Claim 5 recites querying the "data warehouse" to ascertain effectiveness of advertising at terminal(s). The Office Action has not shown this in the applied references.

The Office Action merely asserts that the references show that it is well known that the effectiveness of advertising should be assessed.

But the Office Action has not shown **the particular method claimed in making the assessment** (ie, storing data from terminals in a data warehouse, and querying the warehouse.)

The recitation of claim 5 has not been shown in the prior art.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

##### No Teaching Given

The rationale given for combining the references is that it is desirable to determine the efficiency of advertising, to allow for improvements.

However, that goal does not lead to the **particular method**

**claimed.** That goal (determining effectiveness or efficiency or advertising) can be achieved by other approaches, such as surveys undertaken by poll-takers.

Thus, the rationale given does not actually lead to the claimed invention. A teaching in favor of combining the references has not been shown.

Combination of References not Required to Attain Goal

The Office Action postulates a goal of determining the effectiveness of advertising by ATMs.

However, if one wishes to attain that goal (of determining effectiveness of advertising), one need not combine the references. For example, one could simply contact by mail the ATM customers in Calvey to whom coupons were issued, and ask them if they redeemed the coupons (ie, the advertising). (See Calvey, page 3, paragraph 1.)

Therefore, the stated goal (of determining the effectiveness of advertising by ATMs) does not lead to a combination of references to attain that goal. Other ways to achieve the goal are possible.

No Expectation of Success

Again, the PTO's goal is to determine the effectiveness of advertising by ATMs. In a Calvey-example, the ATM issues discount

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coupons for merchants. Thus, one must ascertain how many people use the coupons.

The PTO has not shown how data is entered into the claimed "data warehouse" which would allow this ascertainment. That is, there is nothing present in the claimed "data warehouse," supposedly found in the references, which tells how many people used the coupons.

MPEP § 706.02(j), cited above, is here repeated:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

No expectation of success has been shown. The supposed data warehouse in the references does not contain the information needed to make the assessment postulated as a goal by the PTO.

**Claim 6**

Even if References Combined, Claim 6 is not Shown - Part 1

The Office Action cites Calvey as stating that the effectiveness of ATM advertising should be assessed.

However, claim 6 does not state that.

Claim 6 recites determining whether (1) a display of advertising is **coincident** with (2) a transaction related to the advertising.

"Coincident" refers to nearness of time.

The assessment of Calvey need not be "coincident."

Restated, claim 6 does not merely refer to an assessment of the effectiveness of advertising, but a **coincident** assessment.

So such coincident assessment has been shown in the references.

Even if References Combined, Claim 6 is not Shown - Part 2

Claim 6 recites determining **how often** the "coincidence" discussed above occurs.

That has not been shown in the applied references.

No Teaching Given

No valid teaching has been given for combining the references.

The rationale given is, in essence, that a better "estimate of efficiency of the advertising" is obtained. However, several



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problems exist in this rationale.

#### PROBLEM 1

No evidence has been given showing that the combination of references actually provides this "better estimate." Evidence is required.

#### PROBLEM 2

No basis of comparison has been given. "Better than" what ? A basis of comparison is required, to determine whether the rationale is correct or not.

#### PROBLEM 3

No combination of references is required to make the estimate. Calvey, by himself, discusses ATMs, and the PTO asserts that Calvey discusses the effectiveness of advertising.

Under this reasoning, De Leo is not needed to determine the effectiveness.

The PTO's rationale, as a matter of logic, does not lead to a combination of references.

#### Claim 10

The discussion of claim 3 applies to claim 10.

### **Claim 12**

#### Even if References are Combined, Claim 12 is not Shown

Claim 12 recites querying the data warehouse, to determine effectiveness of advertising.

That has not been shown in the references, even if combined. Applicant points out that the "data warehouse" is that recited in parent claim 9.

MPEP § 2143.03, cited above, requires this recitation to be shown in the references. It has not been shown.

#### PTO's Rationale does not Lead to Combination of References

The PTO's rationale for combining the references is to "better estimate the efficiency of the advertisement."

However, no combination of the references is required to make that estimate. Calvey shows advertising at ATMs. The efficiency of that advertising can be estimated without De Leo, and the PTO asserts that Calvey, by himself, suggests assessing the effectiveness of advertising. There is no reason to add De Leo.

Pursuit of the stated goal does not lead to a combination of the references.

#### No Evidence Given

The Office Action asserts that the combination of references allows a "better estimate" to be obtained. But no evidence showing

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that the "estimate" is "better" has been given. Evidence is required.

Also, a standard of comparison is required. "Better" than what "

#### **Claim 13**

The discussion of claim 6 applies to claim 13.

Claim 13 recites determining the frequency ("how often") of a particular coincidence. The coincidence is between (1) display of advertising and (2) a transaction relating to the advertising.

That has not been shown in the references.

#### **Claim 18**

The discussion of claim 13 applies to claim 18.

#### **Claim 23**

The discussion of claim 13 applies to claim 23.

#### **DOUBLE PATENTING**

Applicant acknowledges the provisional double patenting rejection, and will submit a terminal disclaimer, if and when required.

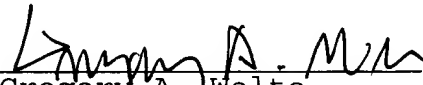
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**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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